

REMARKS

This is in full and timely response to the above-identified Office Action. The above listing of the claims supersedes any previous listing. Favorable reexamination and reconsideration is respectfully requested in view of the preceding amendments and the following remarks.

Claim Objections

The claims have been reviewed and clarifying amendments proposed. These amendments are such as to overcome at least the objections listed in paragraph #2 of this Office Action.

Rejections under 35 USC § 103

- 1) The rejection of claims 1, 3-4, 6, 8-14 and 16-21 under 35 USC § 103(a) as being unpatentable over West et al. in view of Mulroy et al. is respectfully traversed.

It is submitted that while the analysis of the West et al. reference may be suitable for a § 102 rejection, it picks and chooses by reading the claims on the structure disclosed in West et al. and therefore fails to take into consideration the disclosure of the West et al. reference as a whole and would the hypothetical person of ordinary skill. That is to say, the rejection fails to take into consideration the fact that West et al. discloses, in connection with the embodiment shown in Fig. 7B, the use of two cutting features 127 and a sharpened projection 125. This latter mentioned sharpened projection 125 is disclosed at column 5, lines 40-63 of West et al., as follows:

The anchor bolt 100 extends from a first end 130 to a second end 132. Proximate to the first end 130 is the shank 110, and proximate the second end 132 is the drill portion 120. The drill portion 120 has, in one embodiment, a smaller diameter than the shank 110. The drill portion 120, in another embodiment, comprises a drill bit. The drill portion 120 extends from proximate the shank 110 to a drill

tip 124. The drill tip 124, in one embodiment, is sharpened to a point 126. The point 126 of the drill tip 124 is sharpened to assist in the installation process. **In another embodiment, as illustrated in FIG. 1B, the drill tip 124 has a sharpened projection 125 in combination with extended cutting features 127 of the drill portion 120.** The sharpened projection, in one embodiment, is aligned with the radial axis 109 of the anchor bolt 100. The extended cutting features 127 extend from the drill portion to a point 129. **The extended cutting features 127 allow for the anchor bolt 100 to self-tap into a wall, and eliminate the need for extra tools, such as a drill, when installing the anchor bolt.** **The sharpened projection 125 assists in centering the anchor bolt 100 as the extended cutting features 127 engage with the wall.** **In addition, the sharpened projection 125 prevents the anchor bolt 100 from wandering during installation of the anchor bolt 100 into the wall. (Emphasis added)**

It is clear that the sharpened projection 125 and its intended centering/guiding use, would be considered by the hypothetical person of ordinary skill when contemplating a modification of West et al. via a transfer of teachings of Mulroy et al. It is also clear that the projection 125 is not a central cutting element but is located exactly where this central cutting element, if it were to be introduced, would have to be placed. Indeed, inasmuch as all of the embodiments which feature the two cutting features 127 also have the projection 125, it is self-evident that the centering effect and guidance, which is disclosed as being provided by the projection 125, would be considered by the hypothetical person of ordinary skill, to be of importance and would not be ignored for the sake of adding another cutting element - which has yet to be suggested as being necessary.

The MPEP cites *In re Keller* (642 F.2d 413, 208 USPQ 871 (CCPA 1981)) for the proposition that:

"the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference, nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art."

Here "bodily incorporation" is hindered by the need to put a cutting element in the position where a guiding element is located. Further, the introduction of a central cutting element would not be suggested because of need to remove one of the features of West et al. - viz., the wandering attenuating guiding element. Indeed, the removal of the projection 125 in favor of another tooth would be highly apt to remove an important function and render the west et al. arrangement at least partially inoperative for its intended function.

"If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)." M.P.E.P. § 2143.02.

Further:

"If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)." M.P.E.P. § 2143.01.

Thus, a first major stumbling block to the purported obvious combination of West et al. and Mulroy et al. is submitted to exist.

A further problem resides in the position taken with respect to the motivation which is advanced as being sufficient to lead the person of ordinary skill to the claimed subject matter. That is to say, the rejection alleges that the purportedly obvious combination would be made because the resulting configuration would "allow a more concrete engagement of a work piece" "thereby allowing a more efficient drilling event."

Apart from inferring that West et al. is inefficient for its intended purpose, along with the problem that better cutting will not necessary lead to better engagement, the presumption that a more efficient arrangement would result is mere conjecture and amounts to nothing more than a conclusory statement. This must be particularly considered to be the case when the apparent need to replace the centering feature 125, if the claimed subject matter were to be rendered obvious via the combination of West et al. and Mulroy et al., is taken into consideration. Indeed, it must be noted that Mulroy et al, is directed to roll forged drill bits - as different from other production techniques - and that this aspect of the Mulroy et al. reference has not been taken into any consideration in the rejection.

Yet another problem with the rejection is that the Examiner has had to add numerals to the figures of Mulroy et al. to indicate the surfaces which are being claimed and which have been assumed to be found in Mulroy et al. This would seem to be suggestive of the fact that it is necessary to add disclosure, based on a working knowledge of the claimed subject matter, to that which can normally be distilled from Mulroy et al. taken as a whole. It is, after all, the requisite under § 103 that the reference, when taken by a hypothetical person of ordinary skill, would, without modifications/additions, lead toward the claimed subject matter.

Further, it is questionable if the surface the Examiner has labeled (4) is in fact flat. That is to say, the lead line which is associated with the Examiner's added numeral (4) would seem to designate one of the flutes. Flutes by their nature are helically curved and cannot, without very clear contradictory disclosure, be considered to be flat instead of constantly curving. It is therefore, advanced that the assumption that surface (4) is flat, cannot be distilled from any of the information that is available from Mulroy et al. (as it was published) and is indicative that the

claims have been used as road map in this rejection.

It is without question, that in order to arrive at a *prima facie* case of obviousness that the references must "suggest" the claimed subject matter as different from just containing structure which, if appropriately interpreted in light of what is being claimed, could be introduced into another arrangement (i.e. the arrangement disclosed in West et al.) and a rejection cobbled together.

- 2) The rejection of claims 2, 5 and 15 under 35 USC § 103(a) as being unpatentable over West et al. in view of Mulroy et al. and further in view of Carlson et al., is respectfully traversed.

It is respectfully submitted that this rejection fails to establish a *prima facie* case of obviousness for the same reason that the above discussed rejection based on West et al. and Mulroy et al. so fails.

#### Newly presented Claims

New claims 22 and 23 which respectively depend from claims 14 and 20, are added in this response. These claims find full support in at least the drawing wherein essentially straight edges (20) are illustrated. These claims are patentable over the art of record in at least they define structure which is neither found in nor suggested therein.

#### Conclusion

It is respectfully submitted that the claims as they stand before the PTO are clear and distinct and are allowable over the art or record for at least the reasons advance above. Favorable reconsideration and allowance of this application is courteously solicited.

The Examiner is invited to telephone the undersigned Applicant's attorney of record, should such a communication expedite the resolution of any remaining issues and facilitate advancement of the present application.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 07-1337 and please credit any excess fees to such deposit account.

Respectfully submitted,

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Date: **April 25, 2006**